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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,357	10/31/2001	Jerome T. Hartlaub	11738.00045	2290
27581	7590	03/09/2005	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MS-LC340 MINNEAPOLIS, MN 55432-5604			LAU, TUNG S	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,357

Applicant(s)

HARTLAUB, JEROME T.

Examiner

Tung S. Lau

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 and 19-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 14, 17, 29-32 and 39-47 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 12, 15, 16, 18 and 33-38 is/are rejected.
- 7) ☒ Claim(s) 2 and 4-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-14-2005 has been entered.

Election/Restrictions

2. Claims 9-11, 19, 21-25, 20, 26-28 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected without traverse invention as noted in paper 3-23-2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 1, 3, 33, 34, 35, 36, 37, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nappholz et al. (U.S. Patent 5,188,106) in view of Wojcicki et al. (U.S. Patent 5,190,522).

Regarding claim 1:

Nappholz discloses a computing device in communication with an implantable drug delivery device for delivering at least one drug to a patient, the drug delivery device having a reservoir containing at least one drug and a nonconformance monitor module configured to monitor at least one performance parameter, the computing device comprising in combination: (a) a memory having stored therein pump performance acquisition instructions (Col. 29, Lines 24-67); (b) a telemetry module (fig. 10, unit 103) providing bi-directional communication between the computing device and the implantable drug delivery device and providing the pump performance acquisition instructions to the implantable drug delivery device and receiving pump performance data from the implantable drug delivery device (fig. 10, unit 110, 102, 115, 120, Col. 33, Lines 42-56).

Regarding claim 3, Nappholz discloses the memory includes the patient performance requirement information (Col. 33, Lines 42-56). Regarding claim 33, Nappholz discloses the system is a non-programming (Col. 16, Lines 37-52). Regarding claim 34, Nappholz discloses no program change (Col. 2, Lines 3-21). Regarding claim 35, 36 Nappholz discloses programming change (Col. 16-17, Lines 53-14). Regarding claim 37, Nappholz discloses connect to an external device (fig.10, unit 103, 100). Regarding claim 38, Nappholz discloses event associate with pump (Col. 2, Lines 3-41).

Nappholz does not disclose a nonconformance management module contained within the memory receiving the pump performance data and determining whether the pump is conforming to performance requirements, and determining what action should be taken if non conformance is determined; Wojcicki discloses a nonconformance management module contained within the memory receiving the pump performance data and determining whether the pump is conforming to performance requirements, and determining what action should be taken if non conformance is determined (Col. 4, Lines 15-39), in order to have an accurate monitoring system and guarantees that the drug infused into the body of the patient (Col. 4, Lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nappholz to have a nonconformance management module contained within the memory receiving the pump performance data and determining whether the pump is conforming to performance requirements, and determining what action should be taken if non conformance is determined taught by Wojcicki in order to have an accurate monitoring system and guarantees that the drug infused into the body of the patient (Col. 4, Lines 3-6).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2863

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by
Wojcicki et al. (U.S. Patent 5,190,522).

Regarding claim 12:

Wojcicki discloses an implantable drug delivery device having performance data reporting capability comprising in combination: (a) a memory having stored therein pump performance acquisition instructions (Col. 4, Lines 15-39, fig. 1, unit 5, 3) ; (b) at least one nonconformance monitor module for monitoring at least one pump operation variable in accordance with the pump performance acquisition instructions to produce pump performance data (Col. 4, Lines 15-39); and (c) a non-conformance management module receiving the pump performance data, determining whether the pump is conforming to performance requirements, and determining what action should be taken if non-conformance is determined (Col. 4, Lines 15-39).

Regarding claim 16, Wojcicki discloses the nonconforming module patient requirements information is received by non-conformance module (Col. 2-3, Lines 59-7, Col. 1, Lines 29-49).

Art Unit: 2863

b. Claims 15, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wojcicki et al. (U.S. Patent 5,190,522) in view of Nappholz et al. (U.S. Patent 5,188,106).

Wojcicki discloses a system including the subject matter discussed above except telemetry module. Nappholz discloses telemetry module in fig. 10, unit 103, in order to determine the system status remotely (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wojcicki to have telemetry module taught by Nappholz in order to determine the system status remotely (abstract).

Allowable Subject Matter

5. Claims 13, 42-44, 14, 29-32, 39-41, 45, 47, 17 and 46 are allowed.

Reasons for Allowance

6. The following is an examiner's statement of reasons for allowance:

Independent claims 13, 14 and 17 contain allowable subject matter. None of the prior art of record shows or fairly suggests the claimed invention (as noted in office action dated 8-23-2004).

Regarding claims 13, 14:

The primary reason for the allowance of claims 13 and 14 are the inclusion of an implantable drug delivery device having performance data reporting capability including the pump performance data is selected from the group consisting of pump reservoir pressure, fluid outlet pressure, propellant pressure, fluid flow rate, battery current drain, motor current drain, motor drive current profile, battery voltage, and physiologic sensor output level. It is these features found in the claim, as they are claimed in the combination, that has not been found, taught or suggested by the prior art of record which makes this claim allowable over the prior art.

Claims 42-44 are allowed due to their dependency on claim 13.

Claims 29-32, 39-41, 45 and 47 are allowed due to their dependency on claim 14.

Regarding claims 17:

The primary reason for the allowance of claim 17 is the inclusion of an implantable drug delivery device having performance data reporting capability including

Pump manufacturer requirements information that is also received by the non-conformance management module. It is these features found in the claim, as they are claimed in the combination, that has not been found, taught or suggested by the prior art of record which makes this claim allowable over the prior art.

Claim 46 is allowed due to their dependency on claim 17.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Objections

7. Claims 2, 4 and 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitation of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: prior art fail to teach the pump performance data is selected from the group consisting of pump reservoir pressure, fluid outlet pressure, propellant pressure, fluid flow rate, battery current drain, motor current drain, motor drive current profile, battery voltage, and physiologic sensor output level; pump manufacturer requirement information; includes a scheduling module for scheduling an appointment to service the device.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Response to Arguments

8. Applicant's arguments filed 2/14/2005 have been fully considered but they are not persuasive.

A. In response to applicant's arguments against the references individually (Nappholz does not disclose pump performance acquisition instruction, telemetry module of the applicant invention), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung S Lau whose telephone number is 571-272-2274. The examiner can normally be reached on M-F 9-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5841 for regular communications and 703-308-5841 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956. TC2800 FAX Telephone Numbers: 703-872-9306
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TL


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